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First Named Inventor Michael Wayne Brown

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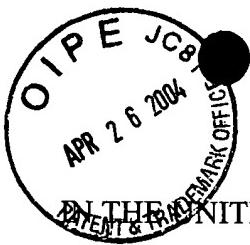
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AUS920010823US1
APPEAL BRIEF

#10
4/29/04

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Michael Wayne Brown, et al.

Serial No.: 10/015,280

Filed: December 12, 2001

Title: Destination Device Based Callee
Identification

§ Group Art Unit: 2645
§ Examiner: Elahee, MD S
§ Atty Docket No.: AUS920010823US1
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APPEAL BRIEF

This is an Appeal Brief filed pursuant to 37 CFR 1.92(a) in response to the Final Office Action of March 5, 2004.

REAL PARTY IN INTEREST

The real party in interest is the patent assignee, International Business Machines Corporation (IBM), a corporation of New York, having a place of business at Armonk, New York 10504.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

The pending claims are 1-30 and 35-39. Claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30 and 35-39 are rejected under 35 U.S.C. 102(e) as being unpatentable by Bartholomew et al. (U.S. Patent No. 6,167,119). Claims 3, 14 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomew et al. (U.S. Patent No. 6,167,119) in view of McAllister (U.S. Patent No. 6,101,242). Claims 5, 6, 16, 17, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomew et al. (U.S. patent No. 6,167,119) in view of Timonen et al. (U.S. Pub. No. 2002/0058494). Claims 7, 18 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomew et al. (U.S. Patent No. 6,167,119) in view of Silverman et al. (U.S. Patent No. 5,875,240). Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomew et al. (U.S. Patent No. 6,167,119) in view of Baker (U.S. Patent No. 5,533,109). All pending claims are on appeal.

STATUS OF AMENDMENTS

No amendments were submitted after final rejection. The claims are presented in the Appendix of Claims as amended in response to an Office Action dated April 11, 2003.

SUMMARY OF INVENTION

Applicants provide the following concise summary of the invention according to 37 CFR 1.192(c)(5), including references to the specification with page and line numbers and to the drawings by reference characters.

Methods, systems, and computer program products are provided for identifying a particular callee. Embodiments include detecting, at a destination device, a voice utterance of a callee; and identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call described for example at page 13, lines 6-16; page 24, lines 15-30; and Figure 4, S12-S22.

Methods, systems, and computer program products are provided for identifying a callee. Embodiments typically include detecting a biometric input at a biometric enabled destination device; identifying a callee identity associated with said biometric input at said destination device, such that said callee identity is transmittable as an authenticated identity of said callee for a call described for example at described for example at page 19, line 27-page 20, line 26.

ISSUES

Whether the claims are properly rejected under 35 U.S.C. § 102(e) and 35 U.S.C. § 103.
More specifically, the issues are:

1. Whether Bartholomew discloses each and every element and limitation of the claims of the present application.
2. Whether Bartholomew provides an enabling disclosure of each and every element and limitation of the claims of the present invention.
3. Whether the combination of Bartholomew and McAllister establishes a *prima facie* case of obviousness.
4. Whether the combination of Bartholomew and Timonen establishes a *prima facie* case of obviousness.
5. Whether the combination of Bartholomew and Silverman establishes a *prima facie* case of obviousness.
6. Whether the combination of Bartholomew and Baker establishes a *prima facie* case of obviousness.
7. Whether the obviousness rejections in the office actions dated April 11, 2003, September 30, 2003, and March 5, 2004, correctly considered and applied the four factual inquires enunciated by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148, U.S.P.Q. 459 (1966).

GROUPING OF CLAIMS

The claims do not stand or fall together. More particularly, if the independent claims stand, then the dependent claims stand together with them. The independent claims, however, fall separately.

The claims include six independent claims (claims 1, 12, 23, 35, 37, and 39), each of which has depending from it a group of dependent claims (claims 2-11, 13-22, 24-30, 36, and 38 respectively). The independent claims 1, 12, and 23 claim respectively method, system, and product aspects of identifying a particular callee. The independent claims 35, 37, and 39 claim respectively method, system, and product aspects for identifying a callee. If the independent claims stand, all the claims stand. Moreover, because the independent claims claim respectively method, system, and product aspects of the present invention, the independent claims all stand if claims 1 and 35 stand. If the independent claims fall, however, the dependent claims may still be patentable individually.

ARGUMENT

Applicants argue in summary:

1. Bartholomew does not disclose each and every element of the claims of the present invention. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).
2. Bartholomew is not an enabling disclosure of the claims of the present invention. “In determining that quantum of prior art disclosure which is necessary to declare an applicant’s invention ‘not novel’ or ‘anticipated’ within section 102, the stated test is whether a reference contains an ‘enabling disclosure’ ... We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must

be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968).

3. The combination of Bartholomew and McAllister does not establish a prima facie case of obviousness.
4. The combination of Bartholomew and Timonen does not establish a prima facie case of obviousness.
5. The combination of Bartholomew and Silverman does not establish a prima facie case of obviousness.
6. The combination of Bartholomew and Baker does not establish a prima facie case of obviousness.
7. The rejection of Applicants claims under 35 U.S.C. § 103 is deficient because the factual inquires necessary to determine obviousness have not been properly considered and determined.

Claim Rejections – 35 U.S.C. 102(e)

Claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30 and 35-39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bartholomew *et al.* (U.S. Patent No. 6,167,119). To anticipate the claims of the present invention under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Bartholomew must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Bartholomew must enable Applicants' claims. Bartholomew does not meet either requirement and therefore does not anticipate Applicants' claims.

Bartholomew Does Not Disclose Each and Every Element of Applicant's Claims

The present application is entitled "Destination Device Based Callee Identification" and each independent claim in the case recites "a destination device." Independent claim 1 recites "[a] method for identifying a particular callee, said method comprising . . . identifying, *at said destination device*, a callee identity associated with said utterance. . ." Independent claim 12 similarly recites "[a] system for identifying a particular callee, said system comprising . . . means for identifying a callee identity associated with said voice utterance *at said destination device*." Independent claim 23 recites "[a] computer program product for identifying a particular callee, said computer program product comprising . . . means, recorded on said recording medium, for identifying a callee identity associate with said voice utterance at *said destination device*." Independent claim 35 recites a "method for identifying a callee, said method comprising" . . . "identifying a callee identity associated with said biometric input *at said destination device*." Independent claim 37 recites a "system for identifying a callee, said system comprising" . . . "means for identifying a callee identity associated with said biometric input *at said destination device*." Independent claim 39 recites a "computer program product for identifying a callee, said computer program product comprising" . . . "means, recorded on said recording medium, for identifying a callee identity associated with said biometric input *at said destination device*." Rejected claims 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, 36 and 38 depend from independent claims 1, 12, 23, 35, and 39 and include all of the limitations of those independent claims.

Bartholomew does not disclose each and every element of Applicants' claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In rejecting claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, and 35-39, the office action

states that the ‘IP 23’ of Bartholomew “reads on the claim ‘destination device.’” The IP of Bartholomew is not a destination device as recited in claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, and 35-39. In fact, Bartholomew teaches away from Applicants’ claims by teaching an intermediary IP. The IP of Bartholomew is an acronym for “intelligent peripheral.” Bartholomew specifically incorporates the definition of the IP from another patent to Wheeler, Jr. U.S. Patent No. 6,167,119, column 11, line 63 – column 12, line 6 [“IP 23 is essentially similar to that disclosed in commonly assigned U.S. U.S. [sic] Pat. No. 5,572583 to Wheeler, Jr. et al. . . . the disclosure of the network and operation of the IP disclosed from that Patent is incorporated herein in its entirety by reference.”]. Wheeler Jr. defines an IP as “*a separate network component* that . . . is distinct from the telephone company switching offices, trunk networks and any associated interoffice signaling network.” U.S. Patent No. 5, 572, 583, abstract, emphasis added. Because the intermediary IP of Bartholomew is not a “destination device,” Bartholomew does not disclose each and every element of Applicant’s claims. As such, rejection of claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, and 35-39 should be withdrawn.

Bartholomew Is Not An Enabling Disclosure of Applicants’ Claims

There are two required aspects of anticipation. Not only must Bartholomew disclose each and every element of the claims of the present invention within the meaning of *Verdegaal* in order to anticipate the claims, but also Bartholomew must be an enabling disclosure of the claims of the present invention within the meaning of *In re Hoeksema*. The Appellants’ claims in *Hoeksema* were rejected because an earlier patent disclosed a close structural similarity to appellant’s chemical compound. The court in *Hoeksema* stated: “We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.” *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The *Hoeksema* court contrasted the so-called ‘Von Brumer doctrine’ with the requirement for a reference to be enabling:

In *In re Brown*, 51 CCPA 1254, 329 F.2d 1006, 141 USPQ 245 (1964), this court discussed *In re Von Bramer*, 29 CCPA 1018, 127 F.2d 149, 53 USPQ 345 (1942), commenting that that opinion should not be construed to encompass what had come to be called the "Von Bramer doctrine." There we stated, 51 CCPA at 1257, 329 F.2d at 1009, 141 USPQ at 247:

This doctrine which appears to have resulted from *In re Von Bramer et al.*, *supra*, seems over a period of years to have been tailored in some quarters to a principle which defeats the novelty of a chemical compound on the basis of a mere printed conception or a mere printed contemplation of a chemical "compound" irrespective of the fact that the so-called "compound" described in the reference is not in existence or that there is no process shown in the reference for preparing the compound, or that there is no process known to a person having ordinary skill in the relevant art for preparing the compound. In other words, a mere formula or a mere sequence of letters which constitute the designation of a "compound," is considered adequate to show that a compound in an application before the Patent Office, which compound is designated by the same formula or the same sequence of letters, is old. We do not think that the Von Bramer case should be so construed.

To the extent that anyone may draw an inference from the Von Bramer case that the mere printed conception or the mere printed contemplation which constitutes the designation of a "compound" is sufficient to show that such a compound is old, regardless of whether the compound is involved in a 35 USC 102 or 35 USC 103 rejection, we totally disagree.

The meaning of *Hoeksema* for the present case is that it is insufficient as anticipation under 35 USC 102(e) for Bartholomew to express a "mere printed conception" or "mere printed contemplation" of some of the elements of the claims of the present application.

Bartholomew's description of an intelligent telephone network that provides personalized communication services based on subscriber prescribed double speech signal processing of utterances of both the calling and answering parties 'mentions' for example the words utterances, but does not enable the claims of the present application. Bartholomew's mere printed mention of a word found in the present application cannot possibly be legally insufficient to show that the present invention is not patentable. The test for sufficiency of enabling disclosure is whether it places an invention in the possession of a person of ordinary skill in the art, and Bartholomew is legally insufficient to enable one of ordinary skill in the art to, for example, identify a particular callee, detect, at a destination device, a voice utterance of a callee; or identify, at said destination device, a callee identity associated with the voice utterance.

The present application is entitled "Destination Device Based Callee Identification" and each independent claim in the case recites "a destination device." Independent claim 1 recites "[a] method for identifying a particular callee, said method comprising . . . identifying, at said destination device, a callee identity associated with said utterance . . ." Independent claim 12 similarly recites "[a] system for identifying a particular callee, said system comprising . . . means for identifying a callee identity associated with said voice utterance at said destination device." Independent claim 23 recites "[a] computer program product for identifying a particular callee, said computer program product comprising . . . means, recorded on said recording medium, for identifying a callee identity associate with said voice utterance at said destination device." Independent claim 35 recites a "method for identifying a callee, said method comprising" . . . "identifying a callee identity associated with said biometric input at said destination device." Independent claim 37 recites a "system for identifying a callee, said system comprising" . . . "means for identifying a callee identity associated with said biometric input at said destination device." Independent claim 39 recites a "computer program product for identifying a callee, said computer program product comprising" . . . "means, recorded on said recording medium, for identifying a callee identity associated with said biometric input at said destination device." Rejected claims 2, 4, 8, 10-13, 15, 19, 21-24,

26, 30, 36 and 38 depend from independent claims 1, 12, 23, 35, and 39 and include all of the limitations of those independent claims.

In rejecting claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, and 35-39, the office action states that the 'IP 23' of Bartholomew "reads on the claim 'destination device'." The IP of Bartholomew is not a destination device as recited in claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, and 35-39. As discussed above, the IP of Bartholomew is an acronym for "intelligent peripheral." Bartholomew specifically incorporates the definition of the IP from another patent to Wheeler, Jr. who defines an IP as "a separate network component that . . . is distinct from the telephone company switching offices, trunk networks and any associated interoffice signaling network." U.S. Patent No. 5, 572, 583, abstract, emphasis added. Because the IP of Bartholomew is not a "destination device," the Bartholomew does not place one of skill in the art in possession of Applicant's claims. Bartholomew is therefore not an enabling disclosure of Applicants' claims. The rejection of claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, and 35-39 should therefore be withdrawn and the case should be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 3, 14 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomew et al. (U.S. Patent No. 6,167,119) in view of McAllister (U.S. Patent No. 6,101,242). Claims 5, 6, 16, 17, 27 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomew et al. (U.S. patent No. 6,167,119) in view of Timonen et al. (U.S. Pub. No. 2002/0058494). Claims 7, 18 and 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomew et al. (U.S. Patent No. 6,167,119) in view of Silverman et al. (U.S. Patent No. 5,875,240). Claims 9 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomew et al. (U.S. Patent No. 6,167,119) in view of Baker (U.S. Patent No. 5,533,109). The proposed combinations of Bartholomew and McAllister, Timonen, Silverman, and Baker do not establish even a *prima facie* case of obviousness and therefore cannot support a rejection under 35 U.S.C. 103. The rejection should therefore be withdrawn and the case allowed.

Bartholomew and McAllister

Claims 3, 14, and 25 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of McAllister. The combination of Bartholomew and McAllister cannot establish a *prima facie* case of obviousness because the proposed combination does not teach each and every element of 3, 14, and 25, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The combination of Bartholomew and McAllister does not teach or suggest all of Applicants' claim limitations. Rejected claims 3, 14 and 25 depend from claims 1, 12, and 23 respectively and include the limitations "identifying, at said destination device, a callee identity associated with said utterance," "means for identifying a callee identity associated with said voice utterance at said destination device," or "means, recorded on said recording medium, for identifying a callee identity associate with said voice utterance at said destination device." Neither Bartholomew nor McAllister teach these limitations. In fact, both Bartholomew and McAllister teach away identifying a callee identity at a destination device by incorporating the same definition of an IP from Wheeler, Jr. U.S. Patent No. 6,167,119, column 11, line 63 – column 12, line 6; U.S. Patent No. 6,101,242, column 12, lines 48-57. Because the combination of Bartholomew and McAllister does not teach each and every limitation of claims 3, 14, and 25, the combination of Bartholomew and McAllister cannot establish a *prima facie* case of obviousness. The rejection should therefore be withdrawn.

There is no suggestion or motivation to combine Bartholomew and McAllister because both references teach away from Applicants' claims. Teaching away from the claims is a *per se* demonstration of lack of *prima facie* obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987).

Both references teach an intermediary IP, not, for example, “identifying, at said destination device, a callee identity.” There is therefore no suggestion or motivation to combine the references, because the resultant combination still does not teach the limitations of claims 3, 14, and 25.

There is no reasonable expectation of success in the proposed combination of Bartholomew and McAllister because the references together do not teach Applicants’ claim limitations and the references together cannot do steps that neither reference teaches alone. Both reference teach an intermediary IP and teach away from identifying *at said destination device*, a callee identity. The combination therefore cannot work to perform steps neither reference discloses. As such, the proposed combination fails to establish a *prima facie* case of obviousness. The rejection should be withdrawn and the case allowed.

Bartholomew and Timonen

Claims 5, 6, 16, 17, 27, and 28 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of Timonen. The combination of Bartholomew and Timonen cannot establish a *prima facie* case of obviousness because the proposed combination does not teach each and every element of 5, 6, 16, 17, 27, and 28, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The combination of Bartholomew and Timonen does not teach or suggest all of Applicants’ claim limitations. Rejected claims 5, 6, 16, 17, 27, and 28 include the limitations “identifying, at said destination device, a callee identity associated with said utterance,” “means for identifying a callee identity associated with said voice utterance at said destination device,” or “means, recorded on said recording medium, for identifying a callee identity associate with said voice utterance at said destination device.” Neither Bartholomew nor Timonen disclose these limitations. As discussed above, Bartholomew teaches an IP which is not a destination device thereby teaching away from Applicants’

claims. Timonen does not teach what Bartholomew lacks. Instead, Timonen discloses an encrypted message containing a digital signature sent to a third party. Timonen, paragraphs 0055 and 0056. An encrypted message containing a digital signature is not identifying, at said destination device, a callee identity associated with said utterance. In fact, a destination device is not even mentioned in the cited sections of Timonen. Because the combination of Bartholomew and Timonen does not teach each and every limitation of claims 5, 6, 16, 17, 27, and 28 the combination of Bartholomew and Timonen cannot establish a prima facie case of obviousness.

There is also no suggestion or motivation to combine Bartholomew and Timonen because Bartholomew teaches away from Applicants' claims. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Bartholomew discloses an intermediary IP, thereby teaching away from Applicants' claims, and Timonen discloses a digital signature. In fact, a destination device is not even mentioned in the cited sections of Timonen. As such, there is no suggestion or motivation to combine the references. The rejection should be withdrawn and the case should be allowed.

There is no reasonable expectation of success in the proposed combination of Bartholomew and Timonen. Because both Bartholomew and Timonen fail to teach "identifying, at said destination device, a callee identity associated with said utterance" the combination cannot work to identify, "at said destination device, a callee identity associated with said utterance." That is, Bartholomew and Timonen together cannot work to do a step that neither reference can do alone. The combination therefore fails to establish a prima facie case of obviousness.

Bartholomew and Silverman

Claims 7, 18, and 29 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of Silverman. The combination of Bartholomew and Silverman also cannot establish a *prima facie* case of obviousness because the proposed combination does not teach each and every element of claims 7, 18, 29, 43, and 48, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of the success in the proposed combination.

The combination of Bartholomew and Silverman does not teach each and every element of claims 7, 18, 29, 43, and 48. Claims 7, 18, and 29 recite an “*origin device* . . . enabled to output said callee identity to a caller.” The office action states “Silverman teaches displaying the called party identification information at the end-user device to which the call is routed before the call is answered.” Office Action Dated April 11, 2003, paragraph 13. The “end-user device to which the call is routed before the call is answered” as described in Silverman at column 2, lines 51-55 cannot be an “*origin device*,” because it is the device *to which the call is routed*. That is, it is the device to which the call is routed not from which the call originated. The proposed combination of Bartholomew and Silverman therefore fails to teach each and every limitation of claims 7, 18, 29, 43, and 48, and cannot establish a *prima facie* case of obviousness.

There is no suggestion or motivation to combine Bartholomew and Silverman, because both Bartholomew teaches away from Applicants’ claims and Silverman teaches away from Applicants’ claims. Teaching away from the claims is a *per se* demonstration of lack of *prima facie* obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Bartholomew discloses an IP, which is not a destination device, thereby teaching away from Applicants’ claims and Silverman discloses “end-user device to which the call is routed before the call is answered” teaching away from an origin device. As such, there is no suggestion or

motivation to combine the references. The rejection should be withdrawn and the case should be allowed.

There is no reasonable expectation of success in the proposed combination of Bartholomew and Silverman because the combination cannot perform steps that neither reference discloses alone. Bartholomew discloses an IP, which is not a destination device, thereby teaching away from Applicants' claims and Silverman discloses "end-user device to which the call is routed before the call is answered" teaching away from an origin device. Bartholomew and Silverman together cannot work to do a step that neither reference can do alone. The combination therefore fails to establish a *prima facie* case of obviousness.

Bartholomew and Baker

Turning now to claims 9 and 20, claims 9 and 20 stand rejected under 35 U.S.C. § 103 as unpatentable over Bartholomew in view of Baker. The combination of Bartholomew and Baker also cannot establish a *prima facie* case of obviousness because the proposed combination does not teach each and every element of claims 9 and 20, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of the success in the proposed combination.

The proposed combination of Bartholomew and Baker does not teach each and every element of claims 9, and 20. Claim 9 depends from independent claim 1 and also includes the limitation "identifying, at said destination device, a callee identity." Claim 20 depends from claim 12 and includes the limitation "means for identifying a callee identity associated with said voice utterance at said destination device." As discussed above, Bartholomew teaches an intermediary IP, which is not a destination device, thereby teaching away from Applicants' claims. Baker does not teach what Bartholomew lacks. Instead, Baker discloses a telecommunications system with a PBX. In fact, a destination device is not even mentioned in the cited sections of Baker. Because the

proposed combination of Bartholomew and Baker fails to teach every element of claims 9 and 20, the combination cannot establish a prima facie case of obviousness.

There is also no suggestion or motivation to combine Bartholomew and Baker because Bartholomew teaches away from Applicants' claims. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Bartholomew discloses an IP, which is not a destination device, thereby teaching away from Applicants' claims and Baker discloses telecommunications system with a PBX and a destination device is not even mentioned in the cited sections of Baker. As such, there is no suggestion or motivation to combine the references. The rejection should be withdrawn and the case should be allowed.

There is also no reasonable expectation of success in the proposed combination of Bartholomew and Baker. Because both Bartholomew and Baker fail to teach "identifying, at said destination device, a callee identity associated with said utterance" the proposed combination cannot work to identify, "at said destination device, a callee identity associated with said utterance." That is, Bartholomew and Baker together cannot work to do a step that neither reference can do alone. The combination therefore fails to establish a prima facie case of obviousness.

The Four Factual Inquiries Required By The Supreme Court For An Obviousness Rejection Have Not Been Properly Considered, Determined, and Applied

Establishing a prima facie case of obviousness for claims 3, 5, 6, 7, 9 14, 16, 17, 18, 20, 25, 27, 28, and 29, which has not been accomplished, is not the end of obviousness analysis, it is the beginning. The rejection of these claims under 35 U.S.C. 103 are deficient because the proper factual inquiries have not been considered, determined, and applied as required by the Supreme Court in *Graham v. John Deere*. The rejection should therefore be withdrawn and the case allowed.

The Manual of Patent Examining Procedure §2141 explicitly states:

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquires may have relevancy. . .

This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

Office policy has consistently been to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquires enunciated therein as a background for determining obviousness are briefly as follows:

- (A) Determining of the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Manual of Patent Examining Procedure §2141.

In over two years of prosecution the Examiner has yet to even mention the four factual inquiries required by the Supreme Court in *Graham v. John Deere*, and all four factual inquiries have not been properly considered, determined, and applied in any of the office actions in this case.

The first factual inquiry that has not been properly considered and determined is ascertaining the differences between the prior art and the claims in issue. More particularly, in each office action the Examiner has only identified elements in Applicants' claims not found in Bartholomew and then attempted to find a similar element in another reference to support an obviousness rejection. Such analysis is improper and incomplete. "Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole." MPEP §2141.02. Furthermore, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *Id.*, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). The office actions of April 11, 2003, September 30, 2003, And March 5, 2004 are deficient because the Examiner has only identified differences between Applicants claims, Bartholomew, McAllister, Timonen, Silverman, and Baker. This analysis is improper and incomplete because Examiner has not determined whether Applicants claims as a whole would have been obvious in view of a combination of Bartholomew and McAllister, Timonen, Silverman, or Baker as required by the Manual of Patent Examining Procedure. In fact, the Examiner has not even mentioned how the claim as a whole would be obvious in rejecting any claim. As such, the obviousness rejections should be withdrawn and the case should be allowed.

The second factual inquiry that has not been properly considered, determined, and applied is resolving the level of ordinary skill in the pertinent art. "The importance of

resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." MPEP §2141.03 citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). "The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). "Factors that may be considered in determining level of ordinary skill in the art include (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). The office actions of April 11, 2003, September 30, 2003, And March 5, 2004 fail to apply a single factor to consider in determining the level of ordinary skill in the art. In fact, in over two years of prosecution and three office actions, no analysis at all considering the level of one of ordinary skill in the art for the instant case has been performed. The rejection is therefore deficient and the case should be allowed.

CONCLUSION

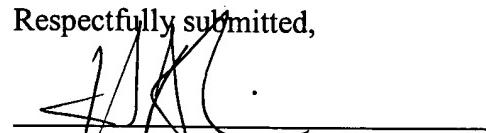
Bartholomew does not teach each and every element of Applicants' claims and does not enable Applicants' claims. Bartholomew therefore does not anticipate claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, and 35-39. The proposed combinations of Bartholomew and McAllister, Timonen, Silverman, or Baker also fail to establish a prima facie case of obviousness because the proposed combinations do not teach each and every element of the rejected claims, there is no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combination. The rejections under 35 U.S.C. § 103 are also deficient because the factual inquires necessary to determine obviousness have not been considered, determined, and applied. Applicants respectfully request the allowance of claims 1-30 and 35-39.

In view of the forgoing arguments, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date: 4/22/04 By:

Respectfully submitted,


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**APPENDIX OF CLAIMS ON APPEAL
IN PATENT APPLICATION OF
MICHAEL WAYNE BROWN, ET AL.; SERIAL NO. 10/015,280**

CLAIMS

What is claimed is:

1. A method for identifying a particular callee, said method comprising:

detecting, at a destination device, a voice utterance of a callee; and
identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.
2. The method for identifying a particular callee according to claim 1, further comprising:

prompting said callee, from said destination device, to provide said voice utterance.
3. The method for identifying a particular callee according to claim 1, further comprising:

prompting said callee to enter an additional input to verify said callee identity.

4. The method for identifying a particular callee according to claim 1, wherein identifying a callee identity further comprises:
 - extracting speech characteristics from said voice utterance; and
 - comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callees.
5. The method for identifying a particular callee according to claim 1, further comprising:
 - transmitting said voice utterance to a third party device via a network; and
 - receiving said callee identity from said third party device.
6. The method for identifying a particular callee according to claim 1, further comprising:
 - requesting a voice sample for said particular callee from a third party device accessible via a network; and
 - receiving said voice sample for said particular callee for enabling authenticating of said callee identity.
7. The method for identifying a particular callee according to claim 1, further comprising:

transferring said callee identity to an origin device, wherein said origin device is enabled to output said callee identity to a caller, wherein said caller is enabled to select whether to communicate with said callee.

8. The method for identifying a particular callee according to claim 1, further comprising:

receiving a preferred callee selection from a caller at said destination device; and

automatically terminating said call if said callee identity is different than said preferred callee.

9. The method for identifying a particular callee according to claim 1, wherein said destination device is a private exchange network.

10. The method for identifying a particular callee according to claim 1, wherein said destination device is a telephony device.

11. The method for identifying a particular callee according to claim 1, wherein said callee identity comprises at least one from among a callee name, a callee location, a subject of said call, and a device identification.

12. A system for identifying a particular callee, said system comprising:

a destination device enabled to receive a call;

means for detecting a voice utterance of a callee at said destination device; and

means for identifying a callee identity associated with said voice utterance at said destination device.

13. The system for identifying a particular callee according to claim 12, further comprising:

means for prompting said callee, from said destination device, to provide said voice utterance.

14. The system for identifying a particular callee according to claim 12, further comprising:

means for prompting said callee to enter an additional input to verify said callee identity.

15. The system for identifying a particular callee according to claim 12, wherein said means for identifying a callee identity further comprises:

means for extracting speech characteristics from said voice utterance; and

means for comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callees.

16. The system for identifying a particular callee according to claim 12, further comprising:

means for transmitting said voice utterance to a third party device via a network;
and

means for receiving said callee identity from said third party device.

17. The system for identifying a particular callee according to claim 12, further comprising:

means for requesting a voice sample for said particular callee from a third party device accessible via a network; and

means for receiving said voice sample for said particular callee for enabling authentication of said callee identity.

18. The system for identifying a particular callee according to claim 12, further comprising:

means for transferring said callee identity to an origin device, wherein said origin device is enabled to output said callee identity to a caller, wherein said caller is enabled to select whether to communicate with said callee.

19. The system for identifying a particular callee according to claim 12, further comprising:

means for receiving a preferred callee selection from a caller at said destination device; and

means for automatically terminating said call if said callee identity is different than said preferred callee.

20. The system for identifying a particular callee according to claim 12, wherein said destination device is a private exchange network.
21. The system for identifying a particular callee according to claim 12, wherein said destination device is a telephony device.
22. The system for identifying a particular callee according to claim 12, wherein said callee identity comprises at least one from among a callee name, a callee location, a subject of said call, and a device identification.
23. A computer program product for identifying a particular callee, said computer program product comprising:
 - a recording medium;
 - means, recorded on said recording medium, for detecting a voice utterance of a callee at a destination device; and
 - means, recorded on said recording medium, for identifying a callee identity associated with said voice utterance at said destination device.
24. The computer program product for identifying a particular callee according to claim 23, further comprising:

means, recorded on said recording medium, for prompting said callee to provide said voice utterance from said destination device.

25. The computer program product for identifying a particular callee according to claim 23, further comprising:

means, recorded on said recording medium, for prompting said callee to enter an additional input to verify said callee identity.

26. The computer program product for identifying a particular callee according to claim 23, further comprising:

means, recorded on said recording medium, for extracting speech characteristics from said voice utterance; and

means, recorded on said recording medium, for comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callees.

27. The computer program product for identifying a particular callee according to claim 23, further comprising:

means, recorded on said recording medium, for transmitting said voice utterance to a third party device via a network; and

means, recorded on said recording medium, for receiving said callee identity from said third party device.

28. The computer program product for identifying a particular callee according to claim 23, further comprising:
 - means, recorded on said recording medium, for requesting a voice sample for said particular callee from a third party device accessible via a network; and
 - means, recorded on said recording medium, for receiving said voice sample for said particular callee for enabling authentication of said callee identity.
29. The computer program product for identifying a particular callee according to claim 23, further comprising:
 - means, recorded on said recording medium, for transferring said callee identity to an origin device, wherein said origin device is enabled to output said callee identity to a caller, wherein said caller is enabled to select whether to communicate with said callee.
30. The computer program product for identifying a particular callee according to claim 23, further comprising:
 - means, recorded on said recording medium, for receiving a preferred callee selection from a caller at said destination device; and
 - means, recorded on said recording medium, for automatically terminating said call if said callee identity is different than said preferred callee.

35. A method for identifying a callee, said method comprising:
 - detecting a biometric input at a biometric enabled destination device;
 - identifying a callee identity associated with said biometric input at said destination device, such that said callee identity is transmittable as an authenticated identity of said callee for a call.
36. The method for identifying a callee according to claim 35, wherein said biometric input comprises at least one from among an eye print, a finger print, a voice input, and a body heat scan.
37. A system for identifying a callee, said system comprising:
 - a biometric input enabled device;
 - means for detecting a biometric input at said biometric input enabled destination device;
 - means for identifying a callee identity associated with said biometric input at said destination device, wherein said callee identity is transmittable as an authenticated identity of said callee for a call.
38. The system for identifying a callee according to claim 37, wherein said biometric input comprises at least one from among an eye print, a finger print, a voice input, and a body heat scan.

39. A computer program product for identifying a callee, said computer program product comprising:
- a recording medium;
- means, recorded on said recording medium, for detecting a biometric input at said biometric input enabled destination device;
- means, recorded on said recording medium, for identifying a callee identity associated with said biometric input at said destination device, wherein said callee identity is transmittable as an authenticated identity of said callee for a call.